

- 1601 Introduction: The Act, Scope, Type of Plants Covered
- 1602 Rules Applicable
- 1603 Elements of a Plant Application
- 1604 Applicant, Oath
- 1605 Specification and Claim
- 1606 Drawings
- 1607 Specimens
- 1608 Examination
- 1609 Report of Agricultural Research Service
- 1610 The Action
- 1611 Issue
- 1612 UPOV Convention

1601 Introduction: The Act, Scope, Type of Plants Covered

The right to a plant patent stems from:

35 U.S.C. 161. Patents for plants. Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

Asexually propagated plants are those that are reproduced by means other than from seeds, such as by the rooting of cuttings, by layering, budding, grafting, inarching, etc.

With reference to tuber propagated plants, for which a plant patent cannot be obtained, the term "tuber" is used in its narrow horticultural sense as meaning a short, thickened portion of an underground branch. Such plants covered by the term "tuber propagated" are the Irish potato and the Jerusalem artichoke. This exception is made because this group alone, among asexually reproduced plants, is propagated by the same part of the plant that is sold as food.

The term "plant" has been interpreted to mean "plant" in the ordinary and accepted sense and not in the strict scientific sense and thus excludes bacteria: *In re Arzberger*, 1940 C.D. 653, 46 USPQ 32, 27 CCPA 1315.

35 U.S.C. 163. Grant. In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

1602 Rules Applicable

37 CFR 1.161. Rules applicable. The rules relating to applications for patent for other inventions or discoveries are also applicable to applications for patents for plants except as otherwise provided.

1603 Elements of a Plant Application

An application for a plant patent consists of the same parts as other applications and must be filed in duplicate (37 CFR 1.163(b)), but only one need be signed and executed; the second copy may be a legible carbon copy of the original. Two copies of color drawings must be submitted, 37 CFR 1.165(b). The reasons for thus providing an original and duplicate file is that the duplicate file is utilized for submission to the Department of Agriculture for a report on the plant variety, the original file being retained in the Patent and Trademark Office at all times.

Applications for plant patent which fail to include two copies of the specification and two copies of the drawing when in color, will be accepted for filing only. The Application Division will notify the applicant immediately of this deficiency and require the same to be rectified within one month. Failure to do so will result in loss of the filing date.

1604 Applicant, Oath

37 CFR 1.162. Applicant, oath or declaration. The applicant for a plant patent must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought (or as provided in §§ 1.42, 1.43 and 1.47). The oath or declaration required of the applicant, in addition to the averments required by § 1.63, must state that he or she has asexually reproduced the plant. Where the plant is a newly found plant the oath or declaration must also state that it was found in a cultivated area.

In an application for a plant patent there can be joint inventors. See *Ex parte Kluis*, Board of Appeals decision in Plant Patent File 707.

1605 Specification and Claim

35 U.S.C. 162. Description, claim. No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

37 CFR 1.163. Specification. (a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

(b) Two copies of the specification (including the claim) must be submitted, but only one signed oath or declaration is required. The second copy of the specification may be a legible carbon copy of the original.

37 CFR 1.164. Claim. The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The specification should include a complete detailed description of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, expressed in botanical terms in the general form followed in standard botanical text books or publications dealing with the varieties of the kind of plant involved (evergreen tree, dahlia plant, rose plant, apple tree, etc.), rather than a mere broad nonbotanical characterization such as commonly found in nursery or seed catalogs. The specification should also include the origin or parentage of the plant variety sought to be patented and must particularly point out where and in what manner the variety of plant has been asexually reproduced. Where color is a distinctive feature of the plant the color should be positively identified in the specification by reference to a designated color as given by a recognized color dictionary.